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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,894	09/11/2003	Sebastian Vogt	100727-57/Heracus 409-KGB	4182
27384 7590 09/23/2009 NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER ROGERS, JAMES WILLIAM				
ART UNIT		PAPER NUMBER		
1618				
MAIL DATE		DELIVERY MODE		
09/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/659,894

Applicant(s)

VOGT ET AL.

Examiner

JAMES W. ROGERS

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-13, 15-19, 21-25 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) 7, 9, 11-13, 17 and 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6, 8, 10, 15-19 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Since applicants amendments only changed the dependence of claim 29, which was still rejected in the previous office action filed 10/02/2008 applicants claims are essentially identical to the previous claim set filed 07/11/2008. Since applicants have already received rejections for these claims in the previous office actions filed 01/11/2008 and 10/02/2008 and the examiner has not made any new rejections since the previous final rejection this action has been made final by the examiner.

Claims 15-16,18,26, 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Whitbourne et al. (US 6,110,483), for the reasons set forth in the previous office action filed 01/11/2008.

Claims 4-6,8,10,15-19,26 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitbourne et al. (US 6,110,483) in view of Watanakunakom et al., ("Effects of combinations of clindamycin with gentamicin, tobramycin, and amikacin against Staphylococcus aureus," in Journal of Antimicrobial Chemotherapy (1980), Vol. 6, No. 6, abstract of pp. 785-791) in view of McGhee (US 6,110,483) in view of Rozzi et al. (US 2003/0138492 A1), for the reasons set forth in the previous office action filed 01/11/2008.

Response to Arguments

Applicant's arguments filed 09/02/2009 have been fully considered but they are not persuasive. Applicants main argument revolves around their belief that Whitbourne does not teach a composite containing an active ingredient suspended in the polymer

composite. As evidence applicants point to passages within Whitbourne that states gentamicin can be made soluble in the coating composition by converting it to lauryl sulfate.

The examiner respectfully disagrees. Whitbourne specifically recites that the active ingredient depending upon the solvent used can be dispersed and not dissolved within the polymer/solvent mixture, thus it is inherent that the active ingredient would be suspended in the polymer once the solvent was evaporated since the active ingredient can be present as discrete particles. See col 8 lin 9-24. It is also inherent that since the polymer coating of Whitbourne contains the same ingredients as applicants claimed invention the composition will have the same settling properties, therefore the active ingredients will inherently form a suspension with the polymer.

Applicants further contend that the forming of a composite is absent from Whitbourne.

The relevance of this assertion is unclear. A composite material is simply a composition with distinct parts and is not seen as very limiting by the examiner. Clearly the composition described within Whitbourne which contains distinct particles and the ingredients are the same the limitation is met.

Conclusion

No claims are allowed at this time.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618